

REMARKS

By this Amendment, Applicants amend claims 1-6, 8, 9, 19, 21, and 23-27. Claims 1-27 remain pending in this application.

In the final Office Action of September 9, 2005¹ ("Office Action"), claims 10-18 were allowed; claims 1-9, 21, and 24-27 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement; claims 1-9 and 19-27 were rejected under 35 U.S.C. § 112, second paragraph, as failing to set forth the subject matter Applicants regard as their invention; claims 1-9 and 27 were rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent Application Pub. No. 2003/0079197 ("*Pannala*"); and claim 24 was rejected under 35 U.S.C. § 103(a) as unpatentable over *Pannala*. Applicants appreciate the Examiner's indication of allowable subject matter and address the rejections below.

Rejection of claims 1-9, 21, and 24-27 under 35 U.S.C. § 112, first paragraph

The Examiner alleged that claims 1-9, 21, and 24-27 contain subject matter that "was not described in the specification in such a way as to enable one skilled in the art . . . to make and/or use the invention." Office Action at 2. The Examiner alleged that Applicants' specification does not enable "a method for designing an element" and the feature of "establishing guidelines for designing an element" *Id.* According to the Examiner, "Applicants' invention involves a method for designing a system that includes an element, not a method of [or tool for] designing an element." *Id.* at 3. Applicants traverse the rejection of claims 1-9, 21, and 24-27 for the following reasons.

¹ The final Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether or not any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the final Office Action.

The test for enablement is whether the disclosure contains sufficient information to enable one reasonably skilled in the pertinent art to make and use the claimed invention without “undue experimentation.” M.P.E.P. § 2164.01. In this case, as explained below, claims 1-9, 21, and 24-27 are fully compliant with the enablement requirement.

Claim 1 recites, *inter alia*, “[a] method of designing a routing element” and “establishing guidelines for designing the routing element” (emphasis added). Applicants have added the term “routing” in claim 1 to further clarify the scope of the claimed “element.” The subject matter recited in claim 1 regarding “designing a routing element” is clearly enabled by the specification. For example, on page 6, ¶ 20, the specification states that “Fig. 2 illustrates an exemplary flow chart of a method for designing a routing element,” and that “the routing element may be a harness.” (emphasis added). On page 7, ¶ 22, the specification states: “[g]uidelines provide general recommendations, rules, and/or standards for designing the harness (emphasis added).” Also, on page 5, ¶ 16, the specification states that “[r]outing design module 124 may include instructions . . . for designing a harness based on the wiring diagram and guidelines 126 (emphasis added).” Moreover, on page 1, ¶ 1, the specification clearly states that the “present invention relates . . . to systems and methods for designing wire or cable harnesses.” Additional support for claim 1 can be found in Fig. 2, page 4, ¶ 14-16, pages 6-8, ¶¶ 20-23.

Given Applicants’ specification and the claim language itself, undue experimentation would not be required to implement and use a method of “designing a routing element” including “establishing guidelines for designing the routing element,” as recited in claim 1.

In the Response to Remarks section of the final Office Action, the Examiner asked: “[w]here is . . . [the feature of establishing guidelines for designing the element] enabled in

Applicants' specification" Office Action at 7. Applicants call the Examiner's attention to page 7, ¶ 22, of the specification, for example, which states:

Next, guidelines are established (step 220). Guidelines provide general recommendations, rules, and/or standards for designing the harness.

Applicants also call attention to page 6, ¶ 20, of the specification, which states that "the routing element may be a harness." The "establishing guidelines" feature of claim 1 is enabled by at least these disclosures in the specification.

The Examiner also alleged that "the recitation of '[a] method [for] designing the element' is incorrect because it is not enabled by Applicants' specification." Office Action at 7. In response, Applicants again call attention to page 6, ¶ 20, of the specification, which states: "Fig. 2 illustrates an exemplary flow chart of a method for designing a routing element." At least this portion of the specification enables the recitation of "a method of designing a routing element."

As to independent claims 21 and 27, the Examiner alleged that the claims lack enablement for the same reasons as those presented for claim 1. As currently presented, claim 21 recites, *inter alia*, "[a] tool for designing a routing element" and "establishing guidelines for designing the routing element." Similarly, amended claim 27 recites, *inter alia*, "[a] method for designing a routing element" and "establishing guidelines for designing the routing element." Claims 21 and 27 are fully enabled by the specification. For example, the above-noted claim recitations are enabled by at least pages 4-5, ¶ 14-16, pages 6-8, ¶¶ 20-23, and Fig. 2 of the specification.

For at least the foregoing reasons, Applicants submit that claims 1, 21, and 27, and dependent claims 2-9 and 24-26, are fully compliant with the enablement requirement of § 112, first paragraph. Accordingly, Applicants request withdrawal of the § 112 rejection of these claims.

In referring to the specification above, Applicants do not intend to limit the scope of the claims to the exemplary embodiments shown in the drawings and described in the specification. Rather, Applicants expressly affirm their entitlement to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation, and applicable case law.

Rejection of claims 1-9 and 19-27 under 35 U.S.C. § 112, second paragraph

Applicants traverse the rejection of claims 1-9 and 19-27 under 35 U.S.C. § 112, second paragraph, for the following reasons.

The Examiner alleged that claims 1-9 and 19-27 do not set forth that which Applicants' regard as the invention. According to the Examiner, "Applicants' invention involves a method of designing a system that includes an element, not a method of [or a tool for] designing an element." Office Action at 3. Applicants disagree with that allegation. To begin with, the Examiner's allegation is completely conjectural and does not in and of itself establish that claims 1-9 and 19-27 fail to correspond to that which Applicants' regard as the invention. Further, as explained above, the specification, on page 6, ¶ 20, clearly states: "Fig. 2 illustrates an exemplary flow chart of a method for designing a routing element," which may be a harness (emphasis added). Also, on page 1, ¶ 1, the specification states that the "present invention relates . . . to systems and methods for designing wire or cable harnesses."

Moreover, Applicants call attention to M.P.E.P. § 2172, which states:

A rejection based on the failure to satisfy this requirement is appropriate only where applicant has stated, somewhere other than in the application as filed, that the invention is something different from what is defined by the claims (emphasis added).

. . . The content of applicant's specification is not used as evidence that the scope of the claims is inconsistent with the subject matter which applicants regard as their invention. As noted in *In re Ehrreich*, 590 F.2d 902, 200 USPQ 504 (CCPA 1979), agreement, or lack thereof, between the claims and the specification is properly considered only with respect to 35 U.S.C. 112, first

paragraph; it is irrelevant to compliance with the second paragraph of that section (emphasis added).

In this case, the Examiner's rejection appears to be based on an alleged disagreement between the claims and the specification. *See* Office Action at 2-3. Even if such a disagreement were present (which it is not), the disagreement would not be germane to the § 112, second paragraph, inquiry. As M.P.E.P. § 2172 makes clear, evidence supporting a § 112, second paragraph, rejection must be from "somewhere other than in the application as filed." The Examiner failed to provide such evidence to support the allegation that claims 1-9 and 19-27 do not correspond to that which Applicants' regard as the invention. M.P.E.P. § 2172. As such, the rejection of these claims under § 112, second paragraph, is improper and should be withdrawn.

Furthermore, in rejecting claim 22, the Examiner mischaracterizes the recitations of the claim. Claim 22 recites a "method of routing an element," not a method of designing an element (emphasis added). To the extent the Examiner is taking the position that "routing an element," as recited in claim 22, does not correspond to that which Applicants' regard as the invention, the Examiner should produce the requisite evidence to support such a position. Should the Examiner continue to dispute the patentability of claim 22, Applicants request clarification in the next Action, which should be non-final, as to the rejection of claim 22 under § 112, second paragraph.

Applicants submit that claims 1-9 and 19-27 are fully compliant with § 112, second paragraph, and request withdrawal of the rejection. Because all of the outstanding rejections of claims 19-22, 25, and 26 should be withdrawn, Applicants request the timely allowance of those pending claims.

Rejection of claims 1-9 and 27 under 35 U.S.C. § 102(e)

Applicants traverse the rejection of claims 1-9 and 27 under § 102(e) because *Pannala* fails to anticipate the claims. In order to properly anticipate Applicants' claimed invention under

35 U.S.C. § 102, each and every element of the claim at issue must be found, either expressly described or under principles of inherency, in a single prior art reference. Further, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.” See M.P.E.P. § 2131. Finally, “[t]he elements must be arranged as required by the claim.” *Id.*

With regard to claim 1, *Pannala* does not teach at least “establishing guidelines for designing the routing element, the guidelines including recommendations for designing the routing element,” as claimed. Although *Pannala* discloses providing to a symbol generator a netlist, which is “a collection of information identifying component pairs and their interconnection,” producing a layout based on the netlist, and producing a wiring diagram according to the layout (§ 0018; Figs. 1, 4, and 5 and accompanying text), *Pannala* does not teach the “establishing guidelines” feature of claim 1. The Examiner acknowledged that *Pannala* fails to disclose establishing guidelines that include recommendations for routing an element. *Pannala* not only fails to disclose establishing guidelines that include routing recommendations, the reference further fails to disclose establishing guidelines that include “recommendations for designing the routing element,” as recited in claim 1.

Because *Pannala* does not teach each and every element of claim 1, as a matter of law, it cannot anticipate this claim. Accordingly, the rejection of claim 1 under 35 U.S.C. § 102(e) based on *Pannala* should be withdrawn. Claims 2-9 and 23 depend upon claim 1 and are distinguishable from *Pannala* for at least reasons similar to those presented above in connection with claim 1. Applicants thus request withdrawal of the § 102(e) rejection and the timely allowance of claims 1-9 and 23.

With regard to independent claim 27, *Pannala* fails to disclose at least “establishing guidelines for designing the routing element, the guidelines including at least information

reflecting a geometry of the system.” While *Pannala* discloses producing a layout along a wiring harness layout dimension (*see, e.g.,* ¶ 0004, ¶ 0018), the reference does not disclose “establishing guidelines for designing the routing element, the guidelines including at least information reflecting a geometry of the system,” as recited in claim 27. Further, *Pannala*’s disclosure regarding symbols, which may be geometric shapes, corresponding to unplaced components (¶ 0022, ¶ 0026) does not constitute “establishing guidelines,” as recited in claim 27. Indeed, neither the relied upon disclosures, nor any other disclosures, in *Pannala*, teach the “establishing guidelines” feature of claim 27. Because *Pannala* does not teach each and every element of claim 27, as a matter of law, it cannot anticipate this claim. Applicants therefore request withdrawal of the § 102(e) rejection and the timely allowance of claim 27.

Rejection of claim 24 under 35 U.S.C. § 103(a)

Applicants traverse the rejection of claim 24 under 35 U.S.C. § 103(a) because a case for *prima facie* obviousness has not been established based on *Pannala*. As M.P.E.P. § 2142 states, “[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.” To establish *prima facie* obviousness under 35 U.S.C. § 103(a), three requirements must be met. First, the applied references, taken alone or in combination, must teach or suggest each and every element recited in the claims. *See* M.P.E.P. § 2143.03 (8th ed. 2001). Second, there must be some suggestion or motivation, either in the reference(s) or in the knowledge generally available to one of ordinary skill in the art, to combine or modify the reference(s) in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of these requirements must “be found in the prior art, and not be based on applicant’s disclosure.” M.P.E.P. § 2143 (8th ed. 2001).

Claim 24 depends upon claim 1 and therefore includes all of the features recited in claim 1, including “establishing guidelines for designing the routing element, the guidelines including

recommendations for designing the routing element.” For at least reasons similar to those presented above in connection with claim 1, *Pannala* does not disclose or suggest the “establishing guidelines” feature. Further, the Examiner has failed to establish that a skilled artisan would have found it obvious to modify the method described in *Pannala* to include the “establishing guidelines” feature. For at least these reasons, *prima facie* obviousness has not been established with respect to claim 24 and the § 103(a) rejection of that claim should be withdrawn.

Claim 24 further recites, *inter alia*, “establishing the guidelines by prompting a user to answer one or more questions.” The Examiner conceded that *Pannala* fails to disclose this feature but alleged that “it would have been obvious . . . that establishing guidelines may be created through system prompt/ user input.” Office Action at 6. According to the Examiner, *Pannala*’s “use of a user interface with input and output devices suggests the possibility of a system prompt and a user response.” *Id.* Applicants disagree with the Examiner’s interpretation of *Pannala*.

Although Fig. 10 of *Pannala* depicts input and output devices, *Pannala* in no way suggests that such devices are used to establish guidelines for designing an element “by prompting a user to answer one or more questions,” as recited in claim 24. The disclosure of input and output devices does not in and of itself signify that those devices are used to establish guidelines for designing an element “by prompting a user to answer one or more questions,” as claimed. Indeed, *Pannala* is silent about establishing guidelines for designing an element “by prompting a user to answer one or more questions.”

Furthermore, the Examiner’s allegations do not establish that a skilled artisan would have found it obvious to modify the method described in *Pannala* to include the features of claim 24.

According to the Federal Circuit, “virtually all [inventions] are combinations of old elements.” See e.g., *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998) (citations omitted). An examiner may find every element of a claimed invention in the prior art but mere identification is not sufficient to negate patentability. *Id.* The court explained that “the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.” *Id.*

In addition, determinations of obviousness must be supported by evidence on the record. See *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001), 59 USPQ2d 1693, 1696-98 (finding that the factual determinations central to the issue of patentability, including conclusions of obviousness by the Board, must be supported by “substantial evidence”). The desire to combine or modify references must be proved with “substantial evidence” that is a result of a “thorough and searching” factual inquiry. See *In re Lee*, 277 F.3d 1338, 1343-1344 (Fed. Cir. 2002), 61 USPQ2d 1430, 1433 (quoting *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52). Additionally, the Federal Circuit has clearly stated that the evidence of a motivation or suggestion to modify a reference must be “clear and particular.” *In re Dembicziak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

In this case, the Office Action does not show, by “clear and particular” evidence, that a skilled artisan considering *Pannala*, and not having the benefit of Applicants’ disclosure, would have been motivated to modify the method described in this reference in a manner resulting in Applicants’ claimed invention. The statement that “use of a user interface with input and output devices suggests the possibility of a system prompt and a user response . . .” does not establish a motivation or suggestion for modifying *Pannala*. Applicants call attention to M.P.E.P.

§ 2143.01, which makes clear that “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination” (citations omitted). The Office Action does not show that *Pannala* “suggests the desirability” of a modification that would result in the combination of elements recited in claim 24.

Furthermore, as M.P.E.P. § 2141.02 articulates, “[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious (internal citations omitted). In this case, the Examiner merely alleged that *Pannala* discloses certain elements without showing reasons why a skilled artisan would be likely to select or modify those elements in a manner that would result in the claimed invention and without showing that the claimed invention as a whole would have been obvious. Alleging that certain features “[suggest] the possibility” of modification or a particular use does not suffice to establish a *prima facie* case of obviousness. Office Action at 6.

Applicants submit that the Examiner is impermissibly using teachings of the present application in hindsight to piece together isolated disclosures of the cited references. Examiners, however, may not pick and choose among isolated disclosures in references to defeat patentability of a claimed invention. Such picking and choosing amounts to improper hindsight reconstruction, and is prohibited. *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988).

For at least the foregoing additional reasons, the § 103(a) rejection of claim 24 should be withdrawn. Applicants thus request withdrawal of the § 103(a) rejection and the timely allowance of claim 24.

Conclusion

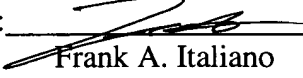
Applicants request the Examiner's reconsideration of the application in view of the foregoing, and the timely allowance of pending claims 1-27. If there are any remaining issues or misunderstandings, Applicants request that the Examiner telephone the undersigned representative in an effort to expedite prosecution of this application.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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